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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,079	02/11/2004	Graham R.F. Napier	TRDB 1007-1	2379

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EXAMINER

SOREY, ROBERT A

ART UNIT	PAPER NUMBER
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4194

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/776,079	Applicant(s) NAPIER ET AL.	
	Examiner ROBERT SOREY	Art Unit 4194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/04/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The use of the trademarks FEDERAL EXPRESS and TRADECARD, INC. has been noted in this application. They should be capitalized or followed by a proper trademark symbol, such as TM or ©, wherever they appear and they should be accompanied by the generic terminology where appropriate.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

2. Claims 3, 10, 17, and 20 are objected to because of the following informalities: the word “with” appears before the word “against” and appears to be extraneous, and for the purposes of examination will not be considered.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d

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1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending U.S. Patent Application Publication No. 2005/0177447. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are all directed to import/export transactions and term negotiations thereof for shipment and release of goods.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0115072 to Manucha et al. in view of U.S. Patent Application Publication No. 2002/0107785 to Melchior et al.

7. As per claim 1, Manucha et al. teaches a computer-aided method of collaborating on conditions to cover an international shipment from an exporter to an importer and confirming performance in accordance with the conditions, the method including:

- setting authorizations for international shipment participants to view and edit aspects of data that records the conditions covering the international shipment, tracks progress of the international shipment participants towards meeting the conditions, and conditions release of the international shipment on fulfillment or waiver of the conditions (see: paragraphs 0014-0015);

- receiving agreed conditions (see: paragraph 0016);

- receiving documentation corresponding to fulfillment of the agreed conditions (see: paragraph 0056); and

- approving release and electronically updating release status of the international shipment, following the evaluation by the exporter that agreed the conditions have been fulfilled (see: paragraphs 0056 and 0069-0070).

8. As per claim 4, Manucha et al. teaches:

- further including exposing to view by the international shipment participants status tracking information regarding establishment of the conditions for insurance coverage, the

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documentation of fulfillment and the approval of fulfillment, abatement or waiver of the conditions (see: paragraphs 0015 and 0016).

9. As per claim 5, Manucha et al. teaches:

--the exposed status information identifies, for particular roles, whether the particular roles are responsible to carry out a next step in the establishment of the conditions, the documentation of fulfillment or the approval of fulfillment, abatement or waiver of the conditions (see: paragraphs 0015 and 0016).

10. Manucha et al. fails to explicitly teach that the conditions of claims 1, 4, and 5 are insurance conditions; however, Melchior et al. teaches a method for collaborating on insurance conditions over a computer network in which shipment participants can negotiate, view, and edit aspects of data (see: paragraphs 0014 and 0039). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate insurance condition functionality into the system of Manucha et al. with the rationale of facilitating the integration of cargo insurance into an electronic import/export trading system (see: paragraph 0013 of Melchior et al.).

11. As per claim 2, Manucha et al. discloses the invention substantially as claimed, see discussion of claim 1, but Manucha et al. fails to specifically point out:

--authorizations to view images of documents.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Manucha et al. with the teachings of Melchior et al. (see: paragraph 0008 of Melchior et al.) with the rational of having copies of

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pertinent documents available to authorized users for the purposes of providing proof of transaction in order to facilitate the early resolution of possible exceptions or problems which could prevent timely payment (see: paragraph 0008 of Melchior et al.).

12. As per claim 3, Manucha et al. discloses the invention substantially as claimed, see discussion of claim 1, but Manucha et al. fails to specifically point out:

--the aspects of data further record filing of insurance claims against a policy applied to the international shipment in accordance with the insurance conditions.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Manucha et al. with the teachings of Melchior et al. (see: paragraphs 39, 149, and Appendix A page 37 - the last illustration in the Appendix) with the rational of quickly providing proof of coverage in order to facilitate the early resolution of possible exceptions or problems which could prevent timely payment (see: paragraph 0008 of Melchior et al.), electronically evaluating whether the agreed upon conditions had been fulfilled (see: paragraph 0016 of Melchior et al.), and/or having a fully integrated international goods and services transaction system (see: paragraph 0013 of Melchior et al.).

13. As per claim 6, Manucha et al. discloses the invention substantially as claimed, see discussion of claim 1, but Manucha et al. fails to specifically point out:

--including selecting standard terms for title transfer/risk allocation in shipment and assigning responsibility for procuring insurance, based on the selected standard terms.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Manucha et al. with the teachings of Melchior et al. (see: paragraphs 147, 148, and 151) with the rational of making available new and valuable ways of providing and obtaining cargo insurance (see: paragraph 0147 of Melchior et al.).

14. As per claim 7, Manucha et al. teaches:

--including tracking the passage of time between steps, comparing the time passed to predetermined values, and alerting a role when excessive delay is detected (see: paragraph 0074).

15. As per claims 8-14, they are rejected for the same reasons set forth in claims 1-7, and Manucha et al. further discloses a computer aided method and system including storage and logic (see: Figs. 1-5, paragraphs 1-46).

16. As per claims 15-17, they are rejected for the same reasons set forth in claims 1-3, and Manucha et al. further discloses a computer aided method and system including storage and logic (see: Figs. 1-5, paragraphs 1-46).

17. As per claims 18-20, they are rejected for the same reasons set forth in claims 1-3, and Manucha et al. further discloses a computer aided method and system including storage and logic (see: Figs. 1-5, paragraphs 1-46).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. In related art U.S. Patent Number 5,717,989 to Tozzoli et al., a full service trade system is disclosed that allows elected participants in an international trade transaction to view documents and approve/deny conditions and payment of the transaction through a computer system (see: abstract).

20. In related art U.S. Publication Number 2003/0040947 to Alie et al. a system for completing an international trade is disclosed that allows a seller/exporter and buyer/importer in different countries to electronically coordinate escrow aspects of both the delivery service system and the payment system (see: abstract).

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT SOREY whose telephone number is (571)270-3606. The examiner can normally be reached on Monday through Friday 7:30AM to 5:00PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Sorey/
Examiner, Art Unit 4194

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 4194